REMARKS

Claims 1-8 are presented for examination. New claims 9-11 have been added to further define the claimed invention.

Claims 1-8 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda et al. (US patent 5,444,664) in view of Robinson et al. (US patent 6,154,788)

This rejection is respectfully traversed for the following reasons.

In the application of a rejection under 35 U.S.C. §103, it is incumbent upon the Examiner to factually support a conclusion of obviousness. As stated in ***Graham v. John Deere Co.*** 383 U.S. 1, 13, 148 U.S.P.Q. 459, 465 (1966), obviousness under 35 U.S.C. §103 must be determined by considering (1) the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; and (3) resolving the level of ordinary skill in the pertinent art.

As demonstrated below, the Examiner has failed to ascertain the differences between the prior art and the claims.

In particular, claim 1 recites a memory system for a portable telephone including a signal transmission/reception portion for transmitting and receiving a signal and a control portion for controlling at least a signal transmission and reception operation of the transmission/reception portion. The memory system comprises:

-a random access memory providing a working area for said control portion; and

-a file storage flash memory for storing a program for said control portion and at least transmission and reception data in a non-volatile manner under a control of said control portion.

The Examiner considers the cordless telephone in FIG. 41 of Kuroda to correspond to the claimed portable telephone. The flash memory FLASH in the microcomputer 102 is considered to correspond to the claimed memory system.

The Examiner appears to admit that the Kuroda memory system does not include a random access memory. Robinson is relied upon for teaching this element.

Considering the references, Kuroda discloses a cordless telephone 100 (FIG. 41) including a baseband unit 101, a microcomputer 102, an HF radio unit 103, a key pad 104 and a power supply unit 105.

It is noted that the Examiner did not point out specifically wherein Kuroda discloses a signal transmission/reception portion for transmitting and receiving a signal, and a control portion for controlling at least a signal transmission and reception operation of the transmission/reception portion.

The microcomputer 102 comprises a CPU and a flash memory FLASH. The reference discloses that the flash memory stores telephone numbers for speed dialing and other information such as memo. For example, voice memo or voice messages may be stored (col. 32, lines 59-66). Further, Kuroda suggests storing in real time "what persons are talking over a telephone line" (col. 32, lines 66-68). Also, the reference suggests using the flash memory as a tape recorder (col. 32, line 68 to col. 33, line 2).

Accordingly, Kuroda does not teach or suggest storing a program for the control portion in the flash memory FLASH.

Hence, Kuroda does not teach or suggest the claimed file storage flash memory for storing a program for the control portion that controls at least a signal transmission and reception operation of the transmission/reception portion, as claim 1 requires.

Robinson is relied upon for disclosing the random access memory only. Accordingly, the Examiner admits that Robinson also does not teach or suggest the claimed file storage flash memory.

Therefore, Applicants submit that combined teachings of the applied references do not teach or suggest the claimed file storage flash memory.

Moreover, it is incumbent upon the Examiner to provide a basis in fact and/or cogent technical reasoning to support the conclusion that one having ordinary skill in the art would have been motivated to combine references to arrive at a claimed invention. ***Uniroyal, Inc. v. Rudkin-Wiley Corp.***, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). The Examiner should recognize that the fact that the prior art *could* be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification. ***In re Deminski***, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. ***In re Oetiker***, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

As demonstrated below, the Examiner has failed to provide the requisite reasons for modifying Kuroda and thus to establish a *prima facie* case of obviousness.

The Examiner contends that RAM memory of Robinson would be added to the flash memory FLASH of Kuroda "to enhance its performance and functionality." However, he provides no factual basis to support his conclusion.

The RAM 430 of Robinson (considered by the Examiner to correspond to the claimed random access memory) is provided for storing configuration signals for an

alternate interface that provides an alternate way for supplying information to a recipient device (col. 6, lines 1-2, 18-22).

Kuroda's system does not have an alternate interface to a recipient device. Moreover, one skilled in the art would recognize that the cordless telephone of Kuroda does not need such an alternate interface.

Hence, no reason is apparent to support the conclusion that one having ordinary skill in the art would have been impelled to add the RAM of Robinson to the cordless telephone system of Kuroda. One skilled in the art would have recognized that no advantage is gained by the proposed combination of references.

Accordingly, Applicants submit that the lack of any motivation for the proposed combination of references to arrive at the claimed invention, coupled with the absence of a teaching or suggestion in the references of the file storage flash memory recited in claim 1, undermine the basis for the Examiner's rejection under 35 U.S.C. § 103. Claims 2-8 dependent from claim 1 are defined over the prior art at least for the reasons presented above in connection with claim 1.

Applicants, therefore, respectfully submit that the rejection of claims 1-8 under 35 U.S.C. § 103 is improper and should be withdrawn.

Newly added claims 9-11 further define the claimed invention. New claim 9 is dependent from claim 1 and, therefore is distinguished over the prior art at least for the reasons presented above in connection with claim 1.

New independent claims 10 and 11 are directed to a portable telephone including the memory system having some elements similar to elements recited in claim 1, such as the file

storage flash memory. Hence, claims 10 and 11 are defined over the prior art at least for the reasons presented above.

In view of the foregoing, and in summary, claims 1-11 are considered to be in condition for allowance. Favorable reconsideration of this application is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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Date: December 24, 2002